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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/015,991

Filing Date: December 06, 2001

Appellant(s): SAIKI ET AL.

MAILED

12/8/2007

GROUP 2800

Nicolas E. Seckel (44,373)
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed July 25, 2007 (7/25/07) appealing from the Office action mailed March 27, 2007 (3/27/07).

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

5,886,819	MURATA et al.	3-1999
6,111,699	IWATA et al.	8-2000

Nagahama et al., "Surface-Protective Film", WO00/44841 A1 (August 3, 2000)

English translation of WO00/44841 A1 to Nagahama et al.

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1-4, 9-10, 27-28 are all rejected under 35 U.S.C. 103(a). These rejections are set forth in the prior Office Action dated 3/27/07, and copied *infra*.

Claims 1-3, 9-10, 27-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nagahama et al. (WO00/44841), of record, in view of Murata et al. (U.S. Patent No. 5886819), of record.

Nagahama et al. discloses an optical member (See Figure 7) in which a surface of an optical material (See 15, 16 in Figure 7) is bonded to and covered with a protective film (See 11, 12 or 14, 11 in Figure 7), wherein the protective film comprises a protective base and an adhesive layer disposed on the protective base so that the protective base can be released together with the adhesive layer from the optical material (See Abstract; 11, 12 or 11, 14 in Figure 7). Nagahama et al. additionally discloses the protective film being disposed on one surface of the optical material (See for example 11, 12 in Figure 7), a separator being provided on an adhesive layer disposed on the other surface of the optical material (See 11, 14 in Figure 7).

so that the separator can be released from the adhesive layer (See 17 in Figure 7), the optical material comprising a polarizing plate (See 16 in Figure 7), a liquid display having the optical member (See Abstract); the protective film thickness not being more than 300 μm (See for example Page 7 (Page 14 of translation of Nagahama et al.), as well as various disclosed examples of the protective film on Pages 17-27 (Pages 31-47 of the translation of Nagahama et al.)); and the protective film being a light-transmitting protective film (See Abstract; various examples disclosed). Nagahama et al. does not explicitly disclose the protective film being transparent and having an outer surface roughness Ra of from 0.03 to 1 μm that does not substantially alter the transparent properties of the protective film. However, Murata et al. teaches a conventional surface protecting antiglare film for use in polarizing films (See for example Abstract of Murata et al.; Figures 1-2). In particular, Murata et al. teaches that the surface protective antiglare film includes a highly transparent substrate (See 11 in Figure 1; 21 in Figure 2; col. 3, lines 15-24), such as a PET or TAC film, that is adhered to a polarizing layer (See 24 in Figure 2; col. 5, line 53-col. 6, line 11). Further, Murata et al. teaches that an outer surface of the surface protective antiglare film may include a surface roughness Ra of 0.03-0.3 micron with a corresponding haze value of 1-25 (See col. 3, line 38-col. 4, line 21). These values are very much in the same order as that of the instant application, and it is expected that the transparent properties of the protective antiglare film will not be significantly altered due to the presence of the surface roughness, as is the case for the instant application (See for example Applicants' declaration dated 4/29/05). Thus, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have the protective film of Nagahama et al., be transparent and have an outer surface roughness Ra of from 0.03 to 1 μm that does not

substantially alter the transparent properties of the protective film, as taught by Murata et al., to ease or simplify inspection of the underlying attached optical material (e.g. a polarizer element) due to a relatively higher contrast, while reducing or eliminating possible glittering effects during viewing.

Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Nagahama et al. in view of Murata et al. as applied to Claim 1 above, and further in view of Iwata et al. (U.S. Patent No. 6111699), of record.

Nagahama et al. in view of Murata et al. discloses the invention as set forth above in Claim 1, except for the optical material further including at least one of a retardation plate and a brightness enhancement plate. However, Iwata et al. discloses an optical member (See for example Figures 6B, 7, 11) in which an adhesive layer (See 34 of Figure 6B) disposed on an outermost surface of an optical material (See 12 in Figure 6B) is provisionally bonded to and covered with a separator (See 36 in Figure 6B). Iwata et al. additionally discloses the separator being disposed on one surface of the optical material (See Figures 6B, 7), a protective film being provided on the other surface of the optical material (See 18, 32 in Figures 6B) having an outer surface roughness Ra of at least 0.03 μm (See Abstract; col. 5, lines 50-65), the optical material comprising a polarizing plate and at least one of a retardation plate and a brightness enhancement plate (See for example 42 in Figure 7; 42, 86 in Figure 11), and a liquid crystal display having the optical member (See for example col. 10, line 25-32). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have the optical

material further include at least one of a retardation plate and a brightness enhancement plate, as taught by Iwata et al., in the optical member of Nagahama et al. in view of Murata et al., for the purpose of reducing the cost and complexity of manufacturing the liquid crystal display panel.

(10) Response to Argument

The Appellant's arguments and remarks filed 7/25/07 in response to the final rejection, dated 3/27/07, have been fully considered, however they are not found persuasive.

A) Response to arguments regarding Claims 1-4, 9-10, 27-28 (See Pages 4-8 of

Appellant's brief filed 7/25/07)

It is Appellant's belief that the Examiner has *failed to identify a teaching, suggestion, or motivation, or other incentive/knowledge/desire that would be sufficient to lead the person of ordinary skill in the art to combine the teachings of Nagahama et al. and Murata et al.* More specifically, Appellant argues that neither Murata et al. nor Nagahama et al. provide any teaching, suggestion, or motivation with respect to an optical member with a temporary protective film having defined surface roughness Ra of from 0.03 to 1.0 µm (i.e. antiglare property). However, it is the belief of the Examiner that a proper teaching, suggestion, or motivation for combining the teachings of Murata et al. and Nagahama et al. was provided with respect to an optical member with a temporary protective film having defined surface roughness Ra of from 0.03 to 1.0 µm.

In support of their arguments, Appellant specifically notes that Murata et al. (i.e. the secondary reference) discloses a permanent antiglare film, and not a removable protective film. However, the Examiner notes that one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642

F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). In the instant case, Nagahama et al. (i.e. the primary reference) already discloses that the protective film (See 11/12 or 14/11 in Figure 7 of Nagahama et al.) includes a protective base substrate and an adhesive layer disposed on the protective base substrate such that the protective base substrate may be released together with the adhesive layer (See in particular Abstract; 5th Paragraph of Page 5, 2nd Paragraph of Page 6 (Pages 10-12 of translation) of Nagahama et al.). Murata et al. was relied upon merely to evidence the conventionally known teachings in the art that protective film substrates may further include a highly transparent substrate (See for example 11 in Figure 1; 21 in Figure 2; col. 3, lines 15-24 of Murata et al.) with a surface having surface roughness Ra on the order of 0.03 to 0.3 µm (i.e. antiglare property; See col. 3, line 38-col. 4, line 21 of Murata et al.). Further, Murata et al. discloses that one of ordinary skill would utilize such surface roughness specifically for the purpose of providing good visibility of whatever is located behind this layer (e.g. a display), while enhancing viewing contrast and reducing or eliminating any possibility of glittering effects (See col. 3, line 38-col. 4, line 21).

In further support of their arguments, Appellant also notes that Murata et al. provides no incentive to add antiglare properties (i.e. the surface roughness) to a temporary film, and instead, the teachings of Murata et al. only applies to displays. The examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In*

re Jones, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the Examiner again notes that Murata et al. specifically discloses that one of ordinary skill would utilize such surface roughness specifically for antiglare properties, i.e. providing good visibility of whatever is located behind this layer, while enhancing viewing contrast and eliminating/reducing any possibility of glittering effects (See col. 3, line 38-col. 4, line 21). Further, both Nagahama et al. (See for example Abstract; Page 1 (Page 3 of translation) of Nagahama et al.) and Murata et al. (See for example Figures 3-4 of Murata et al.) are in the same field of endeavor (i.e. surface protective films for displays), and both specifically disclose the use of these surface protective films for liquid crystal displays. The Examiner also reiterates that one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

B) Response to arguments regarding Claim 4 (See Page 8 of Appellant's brief filed

7/25/07)

It is the Appellant's belief that *the teachings of Iwata et al. fail to teach or reasonably suggest any combination of Murata et al. and Nagahama et al., and that Iwata et al. fails to remedy the deficiencies of Murata et al. and Nagahama et al.* However, it is the belief of the Examiner that the combined teachings of Nagahama et al. and Murata et al. do teach or reasonably suggest the limitations recited in Claim 1 (See arguments set forth above in Section 10A). Again, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

In the instant case, Iwata et al. was cited to merely evidence the generally known teachings in the art to utilize such surface protection films with an optical element that includes a polarizer and a retardation (phase difference) layer (See for example Figures 6B, 7, 11 in Iwata et al.).

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

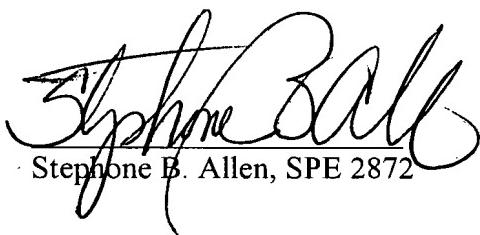
For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,



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10/31/07

Conferees:


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